

REMARKS

Claims 1-23 and 35-49 are pending. In the Office Action mailed on September 28, 2009, the Patent Office rejected claim 16 under 35 U.S.C. § 112, second paragraph; and claims 1-23 and 35-49 under 35 U.S.C. § 103(a) over various combinations of Roskam et al. (US 2003/0044488 A1), Lenchin et al. (US 4,510,166), Fennema ed. (Food Chemistry 3rd Ed.), Lazard et al. (EP 0547551 A1), Tsen et al. (US 3,773,521), and Baur et al. (WO 94/21143). Applicants respectfully request reconsideration of the present application in light of the enclosed amendments to the claims and the following remarks.

Rejections under 35 U.S.C. § 103(a) based primarily on the Roskam et al. '488 application

The Office Action indicates that Roskam et al. (US 2003/0044488 A1) qualifies for §103(a) as a §102(a) reference. Applicants previously submitted a Declaration Under 37 C.F.R. § 1.131 in a Response dated May 26, 2009 to a previous Office Action mailed November 25, 2008, whereby Applicants indicated that the present invention antedates the Roskam et al. reference. The Office Action has again rejected several claims using Roskam et al. as the primary reference under §103(a). Specifically, the Office Action rejected claims 1-5, 7-23, 35-38, 41 and 43-48 as being unpatentable over Roskam et al. in view of Lenchin et al. (US 4,510,166); and claims 6, 39, 40, 42, and 49 as being unpatentable over Roskam et al. in view of Lenchin et al. in further in view of Fennema ed. (Food Chemistry, 3rd Ed.) (Office Action, pp. 2-3). Specifically, in the current Office Action, the Examiner indicated that:

Applicant's affidavit and arguments are not convincing as the affidavit does not establish possession of [the] whole invention as claimed or something falling within the claim, in the sense that the claim as a whole reads on it (MPEP 715.02).

(Office Action at p.6).

Applicants have submitted a Second Declaration Under 37 C.F.R. § 1.131 presenting additional evidence antedating the Roskam et al. reference along with this

response. The documents attached to the presently submitted Second Declaration Under 37 C.F.R. § 1.131 show amounts of starch over the claimed range, specifically from 49.31% one end point of the presently claimed range to 90% as well as two formulas having 52.21% and 53.79%. (See Second Declaration Under 37 C.F.R. § 1.131 at paragraphs 2-6). Contrary to the Examiner's assertion, Applicants are only required to prove conception and reduction to practice of a species of the generic invention prior to the effective date of the reference that would make obvious to one of ordinary skill in the art the species disclosed in the Roskam et al. cited application.

It is settled, of course, that an anticipatory disclosure, not a statutory bar, may be removed as a reference against a generic claim by a Rule 131 affidavit showing prior reduction to practice of as much of the claimed invention as the reference shows. In *re Stempel*, 241 F.2d 755, 44 CCPA 820 (1957). (See further explanation of *Stempel* in *In re Tanczyn*, 347 F.2d 830, 52 CCPA 1630). The Patent Office Board of Appeals, in that case, had held such a showing insufficient, requiring, rather, proof of prior "possession of the *generic* invention." We held that this involved too literal a reading of Rule 131¹ and that "all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show." And this priority need not always be shown directly. **When that species of the generic invention which has been completed prior to the effective date of the reference would make obvious to one of ordinary skill in the art the species disclosed in the reference, the reference may be said to have been "indirectly antedated."** In *re Clarke*, 356 F.2d 987, 53 CCPA 954 (1966); 34 G.W.L.Rev. 507, 525 (1966).

(*In re Ranier*, 390 F.2d 771, 73-74 (C.C.P.A. 1968). (emphasis added). As such, Applicants submit they need only antedate the portion of the reference disclosed by the claim. Moreover, the species of the generic invention has been shown to have been

¹ Rule 131(a) reads:

131. *Affidavit of prior invention to overcome cited patent or publication.* (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication to be more than one year prior to the date on which the application was filed in this country.

completed prior to the effective date (See Declaration Under 37 C.F.R. § 1.131 previously submitted and Second Declaration Under 37 C.F.R. § 1.131 (Exhibit A) submitted along with this response) in this case and, based upon the Examiner's present obviousness rejection of the various claims, would make obvious to one of ordinary skill in the art the species disclosed in the Roskam et al. application. As such, Applicants submit that, at a minimum, the original and/or the presently filed Declaration at least "indirectly antedate" if not directly antedate the Roskam et al. application. Since Applicants have adequately proven that the present invention antedates the Roskam et al. reference, Applicants respectfully submit that the Roskam et al. reference is not properly considered a 103(a) reference in this case and rejections based on this reference should be withdrawn.

Moreover, with respect to the claims requiring "about 32 % corn dextrin" and from "about 32 % to about 40 % corn dextrin," contrary to the Examiner's assertions, the Roskam et al. application does not disclose or suggest greater than 20 % dextrin, but rather teaches away from higher amount and toward lower amounts. Specifically, the Examiner previously stated:

Regarding up to about 32 % dextrin as recited in claim 38 Roskam teaches, in one embodiment that up to 20% dextrin is utilized in the coating composition. Roskam teaches that more dextrin is utilized if a crunchier texture and reduce breakage (i.e. increased tensile strength) is desirable (paragraphs 0034 and 0035). Thus, depending on the thickness of the pastry product and the desired crunchiness of the pastry, one of ordinary skill in the art at the time the invention was made would have been motivated to modify the amount of dextrin in the coating composition. One of ordinary skill in the art at the time the invention was made would have been further motivated to increase the amount of dextrin in the coating composition in order to produce a crunchier pastry product that was stronger (i.e. do not break easily, such as during transportation).

(November 25, 2008, Office Action at p. 6). These specific claim limitations: (1) 32 % corn dextrin from the previously presented claim 38 and (2) from about 32 % to about 40 % corn dextrin in the currently pending dependent claims (claims 10-13, 36,

and 43-47) are not shown in Roskam et al. application and no specific reference to this claim limitation was made in the most recent Office Action with regard to alleged obviousness of the claims both previously presented and currently amended based upon the Roskam et al. application.

As discussed above, the November 25, 2008, Office Action stated that the greater levels of dextrin were supposedly disclosed in paragraphs 0034 and 0035 of the Roskam et al. patent application. Read in context, these passages as well as the application as a whole teach that 20% dextrin is a maximum. Specifically, paragraph 0034 states, in part:

The use of dextrins in the coating mixtures is of importance with respect to increased tensile strength; thus, where increased tensile strength is desirable, **dextrin may be included and used at the higher ends of the approximate ranges indicated above.** Where crispness is more important, and tensile strength less important, the dextrin component may be formulated at lower levels or even omitted altogether (as for example in the case of fried corn dough substrates such as "curls" or "puffs," which do not exhibit a great deal of breakage due to their thicker structure, but may benefit from increased surface crispness).

(paragraph 0034 of the '488 application). (emphasis added). "The approximate ranges indicated above" include 4-20% dextrin (see paragraph 0021 and 0023). As such, the dextrin could go toward the higher end of that range for increased tensile strength. In fact, the blend of functionality of crispness and tensile strength of the '488 reference is more desired as shown in the more specific examples in paragraphs [0043], which disclose dextrin at 10% and 4.9%. These lower amounts further teach away from increasing dextrin beyond the range disclosed. One simply would not have done so, absent hindsight. Since one would have been led away from the invention of dependent claims 10-13, 36, 38, and 43-47, Applicants respectfully submit these claims are allowable for this additional reason as well.

Rejections over Lazard et al. in view of various references.

In the Office Action the Examiner also rejected all of the presently pending claims over the Lazard et al. EP 0547551 application in combination with one or more other references. Specifically, Applicants understand the rejections as follows:

- Claims 1-5, 7-11, 14-20, 22, 23, and 43-46 under 35 U.S.C. §103(a) as being unpatentable over Lazard et al. (EP 0547551 A1) in view of Tsen et al. (US 3,773,521) (Office Action p. 3);
- Claims 12, 13, 21, and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lazard et al. in view of Tsen et al. and further in view of Lenchin et al. (US 4,510,166) (Office Action p. 4);
- Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lazard et al. in view of the combination of Tsen et al. and further in view Fennema ed. (Food Chemistry 3rd Ed.) (Office Action p. 4);
- Claims 35-38, 41, and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lazard et al. in view of the combination of Tsen et al. and Baur et al. (WO 94/21143) (Office Action p. 5); and
- Claims 39, 40, 42 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lazard et al. in view of the combination of Tsen et al. and Baur et al. and in further view of Fennema ed. (Office Action p. 5).

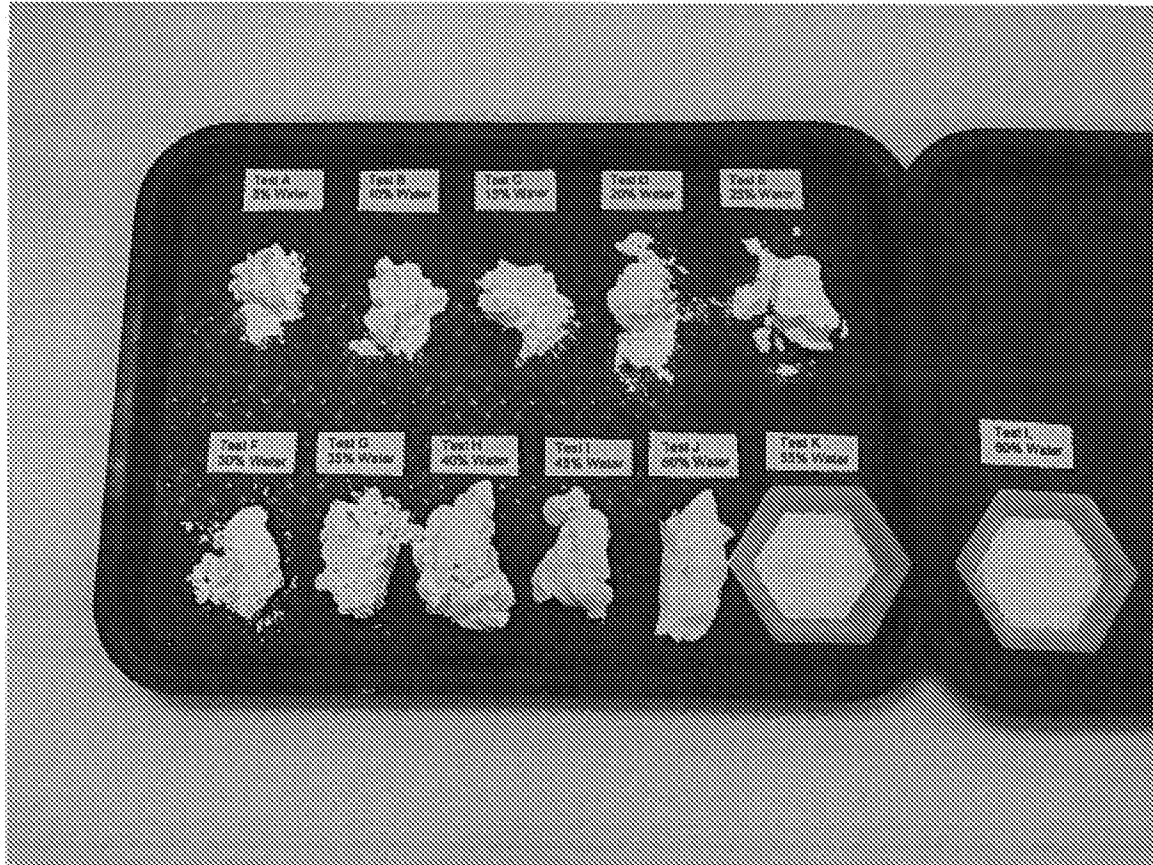
Specifically, with regards to claims 1-5, 7-11, 14-20, 22, 23, and 43-46, the examiner states that:

Lazard teaches that the coating composition is applied as a wet slurry with 5%-40% water and thus 60-95% solids (abstract).

(Office Action p.3) (Emphasis added).

Experiments were conducted on the Lazard et al. ('551 application) as found in the Declaration of Cheree L.B. Stevens submitted as Exhibit B along with this Response. Applicants found that in accordance with the method of the '551

application, a wet slurry was only obtained when more than 55% by weight of the coating water was added to the mixture as shown in Tests K and L.



(See Declaration of Cheree L.B. Stevens ¶8, and Exhibit 2).

Thus, in order to apply the coating as a wet slurry using the method of the '551 application, the coating can only have 45% solids at the most. Further, the Examiner stated that:

Lazard teaches that the coating composition contains 5-40% modified starch component (abstract), 0-5% stabilizers, 0-5% acids and bases, i.e. leavening agents, 0-5% flavorants (page 5 lines 11-16), and 20% corn dextrin (table XII).

(Office Action p.3)

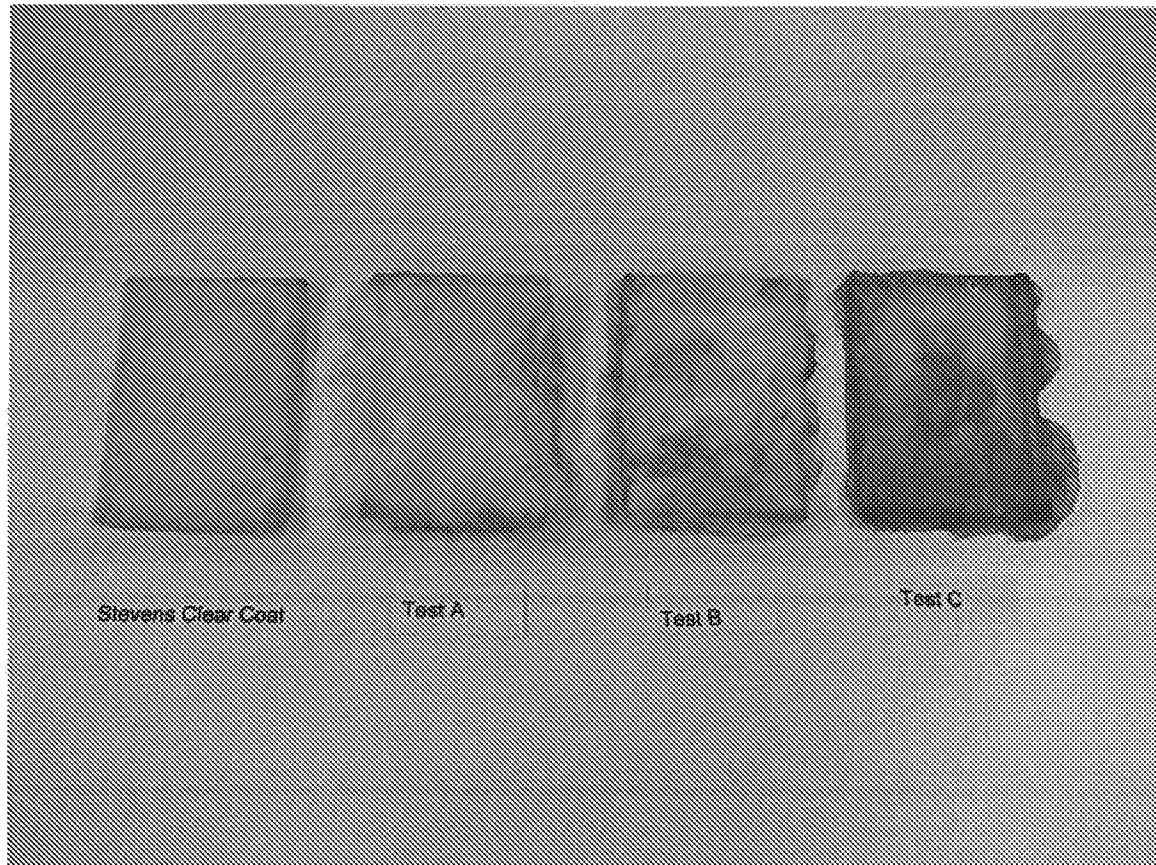
Thus, of the 45% solids maximum that can be added to allow for a slurry coating, 5-40% can be modified starch when applying the coating as a wet slurry. Therefore, based on dry weight of the dried coating composition of the '551

application, the composition of Lazard et al. as a slurry comprises a maximum of only 18% modified starch. In fact, Lazard et al. teaches the use of only 8-35% starch; 10-20% gelatin; 15-30% lipid; and 25-60% water for a moisture barrier composition. This is even a lesser amount of starch and greater amount of gelatin.

As noted in our response of May 26, 2009, the presently pending claims were amended to require from 49.31% by weight (See Example 2 of the present application) to about 100% by weight starch component (claims 1 and 17) or from 49.31% by weight to about 60% by weight wheat starch (independent claim 35). Lazard et al. (the '551 application) does not disclose or suggest such compositions.

With respect to claim 1 (and others) a substantially clear coating composition is claimed. Claim 2 (and others) requires that the coating composition be invisible. The coatings of the '551 application would be opaque and visible due to the incorporation of gelatin. The '551 application itself admits that the coatings are glossy stating specifically that "[t]hese films are characterized by ease of use, ... glossy, non-tacky surface characteristics..." (the '551 application at page 3 lines 2-5). As demonstrated by the experimental results shown in Exhibit 3 of the Declaration of Cheree L.B. Stevens, using the method of the '551 application, coatings for Tests A and B exhibited a coating that did not adhere to the surface of the pastry and raised the skin of the pastry during the baking process. (Declaration of Cheree L.B. Stevens at ¶20, Exhibit 3). The baked coatings were thick, messy, opaque, and readily visible and resulted in a pastry product that no longer resembled a toaster pastry (Declaration of Cheree L.B. Stevens at ¶20, Exhibit 3). Additionally, incorporation of gelatin into the composition of the present invention (Test C) resulted in a coating that did not adhere to the surface of the pastry and raised the skin of the pastry during the baking process. The film was tough, plastic-like, visible, and opaque and lifted away from the pastry surface resulting in a pastry product that no longer resembled a toaster pastry. (Declaration of Cheree L.B. Stevens at ¶21, Exhibit 3). The gelatin had a significantly adverse effect on the coating composition and resulted in a practically inedible product.

(Declaration of Cheree L.B. Stevens at ¶21, Exhibit 3). Exhibit 3 of the Declaration of Cheree L.B. Stevens shows the obvious differences between the inventive coating and those incorporating gelatin.



Accordingly, Applicants submit that the presently pending claims would not have been obvious in light of the '551 application in view of any of the references combined with Lazard et al. by the Examiner in this case. Given that the gelatin of the Lazard et al. application results in a visible, opaque, and readily apparent coating as discussed and shown above, Applicants respectfully submit that the presently pending claims are in condition for allowance and a Notice of Allowance is earnestly solicited.

Applicants: Cheree L. B. Stevens et al.

Appln No.: 10/629,991

Page : 17

If the Examiner has any questions or would like to discuss the application further, please do not hesitate to contact the undersigned at the phone number listed below.


Respectfully submitted,

CHEREE L. B. STEVENS, et al.

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP

3/29/2010
Date

AJW:TAV:jbs


Todd A. Van Thomme
Registration No. 44 285
695 Kenmoor S.E.
P.O. Box 2567
Grand Rapids, MI 49501
Phone: (616) 949-9610
Facsimile: (616) 957-8196